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Edgar Allan Tu

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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDGAR ALLAN TU and ERIC PANG

Appeal 2009-001805
Application 09/618,956¹
Technology Center 2400

Decided: January 26, 2010

Before LEE E. BARRETT, LANCE LEONARD BARRY, and JAY P.
LUCAS, *Administrative Patent Judges*.

LUCAS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed July 19, 2000. The real party in interest is fusionOne, Inc.

STATEMENT OF THE CASE

Appellants appeal from a final rejection of claims 1 to 18 under authority of 35 U.S.C. § 134(a). The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a method of remotely accessing e-mail. (*See* claim 1; Spec. 18, ll. 19.) In the words of Appellants:

No special software is installed on the remote device. To the contrary, remote device may be any device capable of accessing the internet

(Spec. 12, ll. 10-11).

Once connected (and authenticated), [a remote] user will then be presented with task options by the central server system in an internet readable format (HTML for mobile computer user using a browser for instance) by the device being used. The user will then select the task desired at which time the central server system will transmit the task to base computer.

(*Id.* at ll. 16-21).

Claim 1 is exemplary, and is reproduced below:

1. A method for remotely accessing a base computer from internet-enabled remote devices wherein the remote devices do not include remote access server software or remote control system software, comprising in combination:

establishing a remote access session with one of the remote devices at an internet central server system;

presenting a task list to the remote device from said central server system;

receiving a task selection at said central server system from the remote device;

establishing a persistent connection between said central server system and a base computer in response to intermittent contact from said base computer to said central server system;

transmitting said task from said central server system to the base computer via said connection between said central server system and said base computer;

receiving at said central server system task data from the base computer responsive to said transmitted task; and

presenting from said central server system a task response compiled from said task data to the remote device.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Bastian

US 6,757,712 B1

Jun. 29, 2004
(filed Jan. 19, 2000)

REJECTION

The Examiner rejects the claims as follows:

R1: Claims 1 to 11 stand rejected under 35 U.S.C. § 112, 1st paragraph, as not being enabled.

R2: Claims 1 to 11 stand rejected under 35 U.S.C. § 101, as lacking utility.

R3: Claims 1 to 9 and 12 to 18 stand rejected under 35 U.S.C. § 102(e) for being anticipated by Bastian.

Appellants contend that the claimed subject matter is enabled (App. Br. 13, top), has clear utility (*id.* at middle), and is not anticipated by Bastian because the claimed base computer does not read on Bastian's base station 120 (App. Br. 15, middle to bottom). The Examiner contends that each of the claims is properly rejected (Ans. 13, top).

The rejections will be reviewed in the order argued by Appellants. The claims are grouped as per Appellants' Brief. Only those arguments actually made by Appellants have been considered in this opinion. Arguments that Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. §§ 112, 1st paragraph; 101; and 102(e). The issue under 35 U.S.C. § 102(e) specifically turns on whether Appellants' base computer reads on Bastian's base station 90 (App. Br. 15,

middle to bottom) and whether Bastian logs into an “intermediary server,” as recited in claim 16 (App. Br. 16, top).

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence.

Disclosure

1. Appellants have invented a method and system for remotely checking e-mail messages. (*See* Figs. 1-3; Spec. 18, ll. 15-19; Spec. 19, ll. 6-7.) E-mail is sent from the base computer to a central server system and then forwarded to a remote device. (*See* Spec. 19, ll. 11-13.)

Bastian

2. The Bastian reference teaches a Virtual Private Network on an airplane that communicates with a base station located on the ground. (*See* Fig. 1; Abstract; col. 8, ll. 10-14.) Bastian teaches uploading e-mail messages from the station 90 to a server and forwarding the e-mail messages to a PC that is remote (*i.e.*, removed or apart from) relative to the station 90 (*id.* at ll. 27-30).

PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006).

“[L]imitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir.1989)).

To be statutory there must be a tangible application of an algorithm to a “real-world use.” *Ex parte Gutta*, No. 2008-4366, 2009 WL 2563524 (BPAI 2009) (precedential).

In rejecting claims under 35 U.S.C. § 102, “[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation.” *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375 (Fed. Cir. 2005) (citation omitted).

Our reviewing court states in *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989) that “claims must be interpreted as broadly as their terms reasonably allow.”

ANALYSIS

From our review of the administrative record, we find that the Examiner has presented the rejections of Appellants’ claims under 35 U.S.C. §§ 112 paragraph 1; 101; and 102 on pages 3 to 9 of the Examiner’s Answer. In opposition, Appellants present a number of arguments for our review.

*Arguments with respect to the rejection
of claims 1 to 11
under 35 U.S.C. § 112, 1st paragraph [R1]*

First, Appellants argue: “The system uses a central server system and standard communication interfaces such as a web browser. Accordingly, there is no contradiction between claims [1 to 11] and the Specification. The claims recite ... establishing communications that [do] not use [remote access control] or [remote control server] system.” (App. Br. 13, top).

The Examiner maintains that the Specification would not have enabled a person of ordinary skill in the art to make and use the claimed invention. (*See* Ans. 10, middle.)

We select claim 1 as representative. We agree with the Examiner. The claim preamble recites, in relevant part, “the remote devices do not include remote access server software or remote control system software” (claim 1). Contrary to this limitation, the Specification discloses that remote access to e-mail is achieved using “open application” or non-proprietary software (*see* Spec. 5, l. 18) (*e.g.*, a web browser, as Appellants have argued above), as opposed to the “proprietary software” (Spec. 5, l. 1) disclosed in the “Background of the Invention.”

We note that Appellants’ disclosed advantage of an “open application standard,” which is the basis for Appellants’ argument above, is not drawn into the claim language in either the body of claim 1 or its preamble. Rather, the exemplary claim’s preamble broadly states that the remote devices “do not include remote access server software or remote control system software.” Such a negative limitation fails to convey what precisely is used to perform the method steps of claim 1. In other words, we read the

preamble of claim 1 as employing no software (*i.e.*, either proprietary or non-proprietary) to achieve the seven steps specified in the body of the claim.

Since we do not import any limitations from the Specification, *see In re Van Geuns*, 988 F.2d at 1184, and the claim language fails to specify how a person of ordinary skill in the art would have achieved the claimed method steps absent any type of software disclosed in the Specification, we agree with the Examiner's analysis under 35 U.S.C. § 112, 1st paragraph.

*Arguments with respect to the rejection
of claims 1 to 11
under 35 U.S.C. § 101 [R2]*

Appellants argue that claims 1 to 11 “have clear utility” (App. Br. 13, middle).

The Examiner maintains that the claims lack utility because the Specification contains no support for “remote devices [that] do not include remote access server software” (Ans. 4, middle).

In this case, we agree with Appellants. Checking e-mail, as the Specification discloses (*see* FF#1), has a clear “real-world use” that is in accordance with the teachings of *Ex Parte Gutta*, cited above. Accordingly, we find error in the Examiner's analysis on the basis of statutory subject matter.

*Arguments with respect to the rejection
of claims 1 to 9 and 12 to 18
under 35 U.S.C. § 102(e) [R3]*

Appellants argue that the claimed “base computer does not read on Bastian’s station 120.” (App. Br. 15, middle to bottom).

The Examiner did not cite Bastian’s base station 120 as being the same as Appellants’ claimed “base computer” (claim 1) (Ans. 5, bottom). Instead, the Examiner reads station 90 of Bastian as being the same as Appellants’ claimed “base computer.” We find that claim 1 reads on Bastian’s uploading e-mail messages (Appellants’ claimed “task data”) from station 90 (Appellants’ claimed “base computer”) to a server (Appellants’ claimed “central server system”) and forwarding the e-mail messages to a PC (Appellants’ claimed “remote device”) that is remote (*i.e.*, removed or apart from) relative to station 90 (FF#2). Bastian teachings (*see id.*) are no different from the claimed invention, in which e-mail is sent from the base computer to a central server system and then forwarded to a remote device (FF#1). Accordingly, we find no error in the Examiner’s analysis of claims 1 to 9 and 12 to 18.

Regarding independent claim 16, Appellants argue that Bastian fails to teach logging into an “intermediary server,” as claimed (App. Br. 16, top).

In reply, the Examiner finds that Bastian’s server 20 is the same as Appellants’ claimed “intermediary server” (Ans. 12, bottom).

No restriction or limitation has been placed on the claimed “intermediary server” that would preclude Bastian’s server 20 from being equated with the “intermediary server,” as claimed. Moreover, on the record before us, Appellants offer no convincing explanation why a person of

ordinary skill in the art would not have recognized Bastian's server 20 as being the same as the claimed "intermediary server." We find that Appellants' "intermediary server," as claimed, reads on Bastian's server 20. Accordingly, we find no error in the Examiner's analysis of claim 16.

CONCLUSIONS OF LAW

Based on the analysis above, we conclude that the Examiner erred in rejecting claims 1 to 11 under 35 U.S.C. § 101 as lacking utility.

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1 to 18 under 35 U.S.C. § 112, 1st paragraph, and 35 U.S.C. § 102(e), respectively.

DECISION

The Examiner's rejection [R2] of claims 1 to 11 under 35 U.S.C. § 101 as lacking utility is reversed. The Examiner's rejections [R1 and R3] of claims 1 to 18, respectively, are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

peb

Appeal 2009-001805
Application 09/618,956

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